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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,955	03/30/2001	Bill Kitchen	3350-05B	9517

7590

07/05/2005

Alfred A. Stadnicki  
Fifth Floor  
1146 Nineteenth Street, NW  
Washington, DC 20036

EXAMINER

NGUYEN, NGA B

ART UNIT PAPER NUMBER

3628

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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OIP/PA  
JUL 25 2005

\* Did not receive : Returned Mail

Envelope. Chau

## Office Action Summary

**Application No.**

09/820,955

**Applicant(s)**

KITCHEN ET AL.

**Examiner**

Nga B. Nguyen

**Art Unit**

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 34-57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                                                     |                                                                                         |
|-----------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                         | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                                | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/2/01; 12/3/03</u> | 6) <input type="checkbox"/> Other: _____                                                |

### DETAILED ACTION

1. This Office Action is in response to the communication filed on March 30, 2001, which paper has been placed of record in the file.
2. Claims 34-57 are pending in this application.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 34-57 are rejected under the judicially created doctrine of double patenting over claims 1-19 of U. S. Patent No. 6,289,322 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a method for generating electronic billing information comprising: receiving bill data..., normalizing the received bill data..., processing the normalized bill data...; a system for generating electronic billing information comprising: a communications port..., a memory..., a processor in communication with the communications port and the memory, etc.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Conclusion***

5. Claims 34-57 are rejected.
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571-272-6796. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

Art Unit: 3628

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on (571) 272-6799.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3600.

7. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

C/o Technology Center 3600

Washington, DC 20231

Or faxed to:

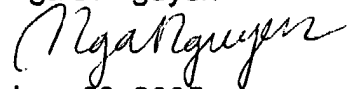
(703) 872-9306 (for formal communication intended for entry),

or

(571) 273-0325 (for informal or draft communication, please label "PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Knox building, 401 Dulany Street, Alexandria, VA, First Floor (Receptionist).

Nga B. Nguyen



June 23, 2005

LIST OF ART CITED BY APPLICANT (PTO-1449)	ATTY. DOCKET NO. 33500-05B	SERIAL NO. 09/820,953
	APPLICANT Kitchen et al	
	FILING DATE March 30, 2001	GROUP 2162 3628

**RECEIVED**  
OCT 04 2001  
Technology Center 2100

**U.S. PATENT DOCUMENTS**

EXAMINER'S INITIALS	PATENT NO.	DATE	NAME	CLASS	SUBCLASS	FILING DATE
<i>nm</i>	5,220,501	06/15/1993	Lawlor et al.	364	408	12/08/1989
	5,287,270	02/15/1994	Hardy et al.	364	408	12/02/1992
	5,325,290	06/28/1994	Cauffman et al.	364	401	10/25/1991
	5,383,113	01/17/1995	Kight et al.	364	401	07/25/1991
	5,465,206	10/07/1995	Hilt et al.	364	406	10/01/1993
	5,483,445	01/09/1996	Pickering	364	406	10/21/1993
	5,655,089	08/05/1997	Bucci	395	240	04/10/1992
	5,699,528	12/16/1997	Hogan	395	240	10/31/1995
	5,832,460	11/3/1998	Bednar et al.	705	27	6/2/1995
	5,930,759	7/27/1999	Moore et al.	705	2	7/1999
	5,873,072	2/16/1999	Kight	705	40	2/1999
<i>nm</i>	5,956,700	9/21/1999	Landry	705	40	9/1999

**OPEN**  
OCT 02 2001  
PATENT & TRADEMARK OFFICE

**FOREIGN PATENT DOCUMENTS**

EXAMINER'S INITIALS	PATENT NO.	DATE	COUNTRY	CLASS	SUBCLASS	Translation	
						Yes	No

**OTHER ART (Including Author, Title, Date, Pertinent Pages, Etc.)**

<i>nm</i>	Dialog File 6, 05424287, Shira Levine, Billing with an Attitude, America's Network, p.78

EXAMINER <i>Ngat Nguyen</i>	DATE CONSIDERED 6/23/05
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EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.

Form PTO-1449	U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE	ATTY. DKT. NO. 3350-05B 1158.41315CV2	SERIAL NO. 09/820,955
<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> (Use several sheets if necessary)		APPLICANT KITCHEN, et al.	
		FILING DATE March 30, 2001	GROUP 3628

**U.S. PATENT DOCUMENTS**

Examiner Initial	Document Number	Date	Name	Class	Subclass	Filing Date
mm	AA 5,649,117	7-15-97	Landry			
	AB 6,035,285	3-7-00	Schlect, et al.			
	AC 6,070,150	5-30-00	Remington, et al.			
	AD 5,794,221	8-11-98	Egendorf			
	AE 5,963,925	10-5-99	Kolling, et al.			
	AF 5,978,780	11-2-99	Watson			
	AG 6,055,567	4-25-00	Ganesan, et al.			
	AH 6,044,362	3-28-00	Neely			
	AI 5,943,656	8-24-99	Crooks, et al.			
	AJ 6,292,789	9-18-01	Schutzer			
	AK 6,289,322	9-11-01	Kitchen, et al.			
mm	AL 5,473,143	12-5-95	Vak, et al.			

**FOREIGN PATENT DOCUMENTS**

Examiner Initial	Document Number	Date	Country	Class	Subclass	Translation /Abstract	
						Yes	No
mm	AM 2294566	5-1-96	Great Britain				
	AN						
	AO						
	AP						
	AQ						
	AR						
	AS						
	AT						

**OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)**

mm	AU	Open Financial Exchange Bill Presentment, June 12, 1997, 1997 CheckFree Corp., Intuit Inc., Microsoft Corp., pgs. 312-356
	AV	
	AW	
	AX	
	AY	
	AZ	
Examiner <i>Ngat Nguyen</i>		Date Considered <i>6/23/05</i>



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**GROUP 3600**

Form PTO-1449

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

ATTY. DKT. NO.

3350-05B  
1158.41315CV2

SERIAL NO.

09/820,955

INFORMATION DISCLOSURE STATEMENT  
BY APPLICANT

(Use several sheets if necessary)

APPLICANT

KITCHEN, et al.

FILING DATE

March 30, 2001

GROUP

3628

## U.S. PATENT DOCUMENTS

Examiner Initial	Document Number	Date	Name	Class	Subclass	Filing Date
YWL	AA 6,128,603	10-3-00	Dent, et al.			
	AB 6,285,991	9-4-01	Powar			
	AC 2002/0023055	2-21-02	Antognini, et al.			
	AD 5,007,084	4-9-91	Materna, et al.			
	AE 5,684,965	11-4-97	Pickering			
	AF 6,052,674	4-18-00	Zervides, et al.			
	AG 6,078,907	6-20-00	Lamm			
YWL	AH 6,188,994	2-13-01	Egendorf			
	AI					
	AJ					
	AK					
	AL					

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GROUP 3600

## FOREIGN PATENT DOCUMENTS

Examiner Initial	Document Number	Date	Country	Class	Subclass	Translation /Abstract	
						Yes	No
	AM						
	AN						
	AO						
	AP						
	AQ						
	AR						
	AS						
	AT						

## OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)

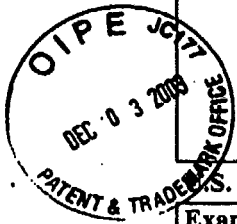
	AU	
	AV	
	AW	
	AX	
	AY	
	AZ	

Examiner

Ngan Nguyen

Date Considered

6/23/05





<b>Notice of References Cited</b>	Application/Control No. 09/820,955	Applicant(s)/Patent Under Reexamination KITCHEN ET AL.	
	Examiner Nga B. Nguyen	Art Unit 3628	Page 1 of 1

**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-6,289,322	09-2001	Kitchen et al.	705/40
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

**FOREIGN PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

**NON-PATENT DOCUMENTS**

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

## **NEW CENTRAL FAX NUMBER**

Effective July 15, 2005

On July 15, 2005, the Central FAX Number will change to **571-273-8300**. This new Central FAX Number is the result of relocating the Central FAX server to the Office's Alexandria, Virginia campus.

Most facsimile-transmitted patent application related correspondence is required to be sent to the Central FAX Number. To give customers time to adjust to the new Central FAX Number, faxes sent to the old number (703-872-9306) will be routed to the new number until September 15, 2005.

After September 15, 2005, the old number will no longer be in service and **571-273-8300** will be the only facsimile number recognized for "centralized delivery".

**CENTRALIZED DELIVERY POLICY:** For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), and facsimile transmissions must be sent to the Central FAX number, unless an exception applies. For example, if the examiner has rejected claims in a regular U.S. patent application, and the reply to the examiner's Office action is desired to be transmitted by facsimile rather than mailed, the reply must be sent to the Central FAX Number.